

## **REMARKS/ARGUMENTS**

Claims 1, 2, 5-14, 19-22, 28, and 29 were previously pending in the application. Claims 1, 5, 6, and 8-13 are amended, and new claims 44-58 are added herein. Assuming entry of this Amendment, claims 1, 2, 5-14, 19-22, 28, 29, and 44-58 are presently pending. The title and portions of the specification have also been amended herein. The Applicant hereby requests further examination and reconsideration of the application in view of the foregoing amendments and these remarks.

In paragraph 3, the Examiner rejected claims 6, 9, and 12 under 35 U.S.C. §102(b) as being anticipated by Murata et al., U.S. Patent No. 4,962,524 ("Murata"). In paragraph 4, the Examiner rejected claims 1, 2, and 19-22 under 35 U.S.C. §103(a) as being unpatentable over Tsukada et al., U.S. Patent No. 4,650,931 ("Tsukada") in view of Murata, and rejected claims 5, 7, 8, 10, 11, 13, 14, 28, and 29 under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Tsukada.

For the following reasons, the Applicant submits that claims 1, 2, 5-14, 19-22, 28, and 29 are allowable over the cited references.

Murata discloses a cordless telephone having a base unit and a plurality of radio telephone sets. (Abst.; col. 2, line 26 to col. 3, line 7.) First, a connection is established between a first one of the radio telephone sets and an outside caller via the telephone network. (*Id.*) Subsequently, the party who is using the first radio telephone set and wishes to transfer the outside caller to a second one of the radio telephone sets activates a function that causes the base unit to deliver a ringing signal to the second radio telephone set to notify the party using the second radio telephone set of the desired transfer. (*Id.*) This ringing signal is also delivered to the first radio telephone set so that the party transferring the call can tell whether the party at the second radio telephone set has answered the call being transferred. (*Id.*) If the second radio telephone set responds to the ringing signal and goes off-hook, then the outside caller is automatically transferred to the second radio telephone set. (*Id.*) If the second radio telephone set does not respond or does not go off-hook, then the first radio telephone set can respond to the ringing signal by going off-hook to resume the telephone communication with the outside caller. (*Id.*)

Tsukada discloses a cordless telephone having a base unit and a separate handset unit. (Abst.; col. 2, line 65 to col. 3, line 64.) The telephone is operable in an intercom mode in which users at the base and handset units are in communication with one another. (*Id.*) If an incoming outside telephone call arrives during this intercom mode, the loudspeaker of the handset unit and a ringer of the base unit both produce a ringing sound to announce the call. (*Id.*) When a user of one of the units hangs up, the intercom mode terminates, and the other unit is automatically connected to the telephone network line to receive the incoming outside telephone call. (*Id.*)

### **Claims 1, 2, and 19-22:**

Claim 1 stands rejected as obvious over Tsukada in view of Murata. Claim 1, as amended, recites, *inter alia*, the following step: "after the incoming call is answered and while the incoming call is active, initiating an intercom connection, by an intercom initiating party, to alert an intercom receiving party, the intercom connection permitting voice communication between the intercom initiating party and the intercom receiving party." While Tsukada does disclose establishing an intercom connection between a base unit and a handset unit, Tsukada does not teach initiating an intercom connection that permits voice communication between handsets. To the contrary, Tsukada teaches a telephone system that is operable as follows: First, the system is in an intercom mode, i.e., a user at the base is in communication with a user at the handset. (col. 2, lines 47-53; col. 14, line 32 to col. 15, line 55.) Subsequently, if an incoming outside telephone call arrives while the base and handset are in the intercom mode, the loudspeaker of the

handset unit and a ringer of the base unit both produce a ringing sound to announce the call. (*Id.*) When a user of either the handset or the base unit hangs up, the intercom mode terminates, and the other unit is automatically connected to the telephone network line to receive the incoming outside telephone call. (*Id.*) Tsukada is therefore distinguishable from claim 1 for at least two reasons: (1) the order of the steps is different, i.e., Tsukada teaches first establishing a connection with an outside telephone line, and then establishing an intercom connection, whereas claim 1 requires first establishing an intercom connection, and then establishing a connection with an outside line; and (2) Tsukada teaches terminating the intercom connection before establishing a connection with an outside line, whereas, in claim 1, an intercom connection is initiated while the incoming call with an outside telephone line is still active. Thus, nowhere does Tsukada teach, disclose, or even suggest establishing an intercom connection after an incoming telephone call is answered and while an incoming telephone call is active, nor the desirability of implementing such a feature, nor the means for implementing such a feature. Murata fails to supply the missing teachings. As explained above, Murata does not teach, disclose, or even suggest employing intercom functionality between the transferring telephone set and the receiving telephone set. Accordingly, neither Tsukada nor Murata, taken either alone or in combination, can render obvious claim 1, which is therefore allowable over these cited references.

Since claims 2 and 19-22 depend variously from claim 1, it is further submitted that those claims are also allowable over Tsukada and Murata.

Claims 5, 28, and 29:

Claim 5 stands rejected as obvious over Murata in view of Tsukada. Claim 5, as amended, recites, *inter alia*, the following step: “the first party alerting a second party, by initiating an intercom connection between said first handset and said second handset, while the incoming call is automatically placed in a hold status, the intercom connection permitting voice communication between the first party and the second party.” As explained above, nowhere does Murata teach, disclose, or even suggest employing intercom functionality between the transferring telephone set and the receiving telephone set. Tsukada fails to supply the missing teachings. As explained above, Tsukada teaches that either the handset unit or the base unit can hang up to terminate the intercom mode when an incoming telephone call arrives, causing the other unit to be connected with an incoming telephone call. However, as discussed above, Tsukada does not teach, disclose, or even suggest establishing an intercom connection after an incoming telephone call has been received or while an incoming telephone call is on hold. Accordingly, neither Murata nor Tsukada, taken either along or in combination, can render obvious claim 5, which is therefore allowable over these cited references.

Since claims 28 and 29 depend variously from claim 5, it is further submitted that those claims are also allowable over Murata and Tsukada.

Claims 6-8, 9-11, and 12-14:

Claims 6, 9, and 12 stand rejected as anticipated by Murata. Claims 6, 9, and 12, as amended, recite, *inter alia*, that “the intercom communication permit[s] voice communication between at least two of said base station and said handsets.” To the contrary, Murata teaches the transfer of a call from an outside-line subscriber wherein the only means of communication between the transferring telephone set and the receiving telephone set is a ringing tone. In other words, the cordless telephone of Murata is configured such that a connection is first established between a first one of the radio telephone sets and an outside caller via the telephone network. (Abst.; col. 2, line 26 to col. 3, line 7.) Subsequently, the party who is using the first radio telephone set and wishes to transfer the outside caller to a second one of the

radio telephone sets activates a function that causes the base unit to deliver a ringing signal to the second radio telephone set to notify the party using the second radio telephone set of the desired transfer. (*Id.*) This ringing signal is also delivered to the first radio telephone set so that the party transferring the call can tell whether the party at the second radio telephone set has answered the call being transferred. (*Id.*) If the second radio telephone set responds to the ringing signal and goes off-hook, then the outside caller is automatically transferred to the second radio telephone set. (*Id.*) If the second radio telephone set does not respond or does not go off-hook, then the first radio telephone set can respond to the ringing signal by going off-hook to resume the telephone communication with the outside caller. (*Id.*) In this scenario, the user at the transferring radio telephone set can hear the ringing tone and recognize that the receiving radio telephone set is being called. (Col. 3, lines 8-19.) When the ringing tone does not stop for a long period of time, the user also recognizes that no one is at the receiving radio telephone set. (*Id.*) At that time, the user at the transferring radio telephone set can inform the outside-line subscriber that no one is at the receiving radio telephone set. (*Id.*) Nowhere does Murata teach, disclose, or even suggest employing any intercom functionality between the transferring telephone set and the receiving telephone set that permits voice communication between the telephone sets or between the telephone set and the base. Accordingly, Murata cannot anticipate any of claims 6, 9, and 12, all of which are therefore allowable over Murata.

Since claims 7, 8, 10, 11, 13, and 14 depend variously from claims 6, 9, and 12, it is further submitted that those claims are also allowable over Murata.

The Applicant submits therefore that the rejections of claims under Sections 102 and 103 have been overcome.

New Claims 44-58:

Support for new claims 44-58 is found, e.g., in FIGs. 4a and 6a and in the specification at p. 14, line 13, to p. 22, line 9. and p. 23, line 24, to p. 35, line 2. Independent claim 44 recites, *inter alia*, the steps of (a) making a first connection for voice communication between a first device and an external telephone; and (b) placing the first connection on hold while attempting to make a second connection for voice communication between the first device and a second device.

Independent claim 49 is a system claim reciting, *inter alia*, steps corresponding to (a) and (b) of claim 44, and independent claim 54 is a claim to a base station reciting, *inter alia*, steps corresponding to (a) and (b) of claim 44. These independent claims and claims 45-48, 50-53, and 55-58 depending variously therefrom are all believed to be allowable over Murata and Tsukada, since neither reference, whether taken alone or in combination, teaches placing on hold a voice communication between a first device and an external telephone while attempting to make a second connection for voice communication between the first device and a second device.

For the foregoing reasons, the Applicant submits that all of the now-pending claims are allowable over the cited references.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Respectfully submitted,

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